

## **REMARKS/ARGUMENTS**

### ***Amendment to the Specification***

The priority claim has been amended to correspond more exactly with the chain of copendency. Although this application is, in substance, a "divisional" of U.S. Patent No. 6,562,037, priority to that application proceeds through copending 10/310,203. Please note that the preliminary amendment already claimed priority to 10/310,203 as a "related" application. Thus, no petition or fees are required under 37 CFR 1.78.

### ***Status of the Claims***

Claims 39-41 and 65-78 are pending in the application. Claim 39 has been amended to recite "an ***adjustable*** stop member that limits the extent to which the forceps may be deformed, the stop member being ***adjustable*** to accommodate the bonding of tissues of varying thicknesses." Dependent claims have been added that further define the form of the adjustable stop member. Two similar new independent claims have been added, one directed to an apparatus with a forceps, electrodes, and "stop means for ***selectively*** limiting the extent to which the forceps may be deformed" and "a stop member that has two ***selectable*** levels for limiting the extent to which the forceps may be deformed."

These amendments do not add new matter. Paragraph 48 of the published application states that "[t]he edges 5, 6 are preferably clamped with a *preset pressure* of a certain experimentally determined magnitude depending on tissue structure and thickness, and the bonding current is passed through these clamped edges." Paragraph 52 advises "pressure P applied to flange 10 by the arms 8 through electrodes 11 ... not exceed 15 N/mm<sup>2</sup> and be no lower than 0.5 N/mm<sup>2</sup>" and cautions against exceeding "the maximal acceptable pressure value P for a particular type of tissue with a certain thickness" or decreasing the pressure "below a minimal acceptable value for a certain type of tissue with a [given] thickness." Paragraph 100 states that "[d]uring the *second stage* it is preferable to *increase the clamping force* applied by the electrodes for the purpose of creating the best conditions for creating a bond."

To facilitate these ends, the specification provides examples of forceps on Figs. 16 and 18 with different types of stop members 104, 116 in Figs. 17 and 19. Describing Fig. 16, paragraph 171 states that "One of arms 8 has a lug 104 on the internal side of the arm. It is possible to limit deformation of arms 8 and thus adjust the clamping force of the electrodes on the tissue by replacing this part 104 with another of a different height." Paragraph 175 states that "The adjustment of the forceps to the needed force P<sub>1</sub> is achieved by replacing part 104 by a similar one but of a different height, or by means of changing the number of adjusting spacers 106 placed under lug 104." Paragraph 182 describes "a knob 108 with a recess 109 for the operator's finger on the external side of the arm."

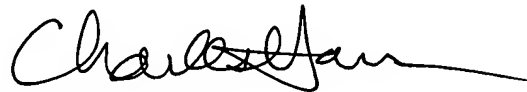
Paragraph 191 describes the tool of Figs. 18 and 19 as having "two level settings of the clamping force using an electromagnetic drive." Paragraph 191 explains that "the deformation is limited not to one certain level but to two selectable levels." Paragraphs 193 and 194 describe the components of this electromagnetic drive and their interaction with other associated components of the stop member.

The Examiner's July 28, 2004, Office Action rejected claims 39-41 and 65 as anticipated by Rydell et al. (US 5445638). Applicants respectfully submit that the amendments to the claims patentably distinguish the claims from Rydell.<sup>1</sup> Rydell discloses several embodiments of a bipolar coagulation and cutting forceps. All of the embodiments use a pivotally mounted moveable arm 42 (Figs. 2, 6) or lever arm 110 (Figs. 7A-7C) to open and close the coagulating forceps 18. In Figs. 2 and 6, the extent to which the forceps can be clamped appears to be limited by the walls of a cavity 50, against which the flanges 52 and 54 of a moveable spool 48 may abut. Similarly, in Figs. 7A-7C, the extent to which the forceps can be clamped is limited by the walls of the cavity 114 in which a translating block 100 moves. But Rydell et al. does not anywhere teach or suggest that the position of the flanges, cavity walls, or any other part of the tool be adjusted or replaced in order to selectively limit the forceps' clamping extent or force.

### ***Conclusion***

In view of the foregoing amendments and arguments, Applicants respectfully ask that the rejections be withdrawn. Believing that all things raised in the Examiner's July 28, 2004, Office Action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully submitted,



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<sup>1</sup> Applicants note that even in their original form, Rydell did not anticipate the claims. Rydell did not appreciate, teach or suggest that the electrodes be dimensioned relative to size of said tissue portion to be an effective heat sink for conducting heat away from said tissue. Rydell did not discuss the preferred or appropriate size of the electrodes at all. Rydell also had no disclosure teaching that the electrodes be dimensioned to have a volume which is at least 5 times that of the tissue portion volume. Nevertheless, Applicants have amended the claims because the scope of claim 39, in its original form, was so close to the scope of issued claim 28 of U.S. Patent No. 6,562,037. Applicants believe that it is more profitable, in this application, to instead to pursue protection of the adjustable clamping force/extent feature. This statement is intended and believed to rebut any presumption that the amendments made to this claim surrendered any scope of protection offered by the doctrine of equivalents.